

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Hadfield, Cindy

SERIAL NO.: 10/647,849      GROUP: 3609

FILED: 08.25.2003              EXAMINER: Fields, Benjamin S

FOR:              Web-Based Check Ordering System

APPEAL BRIEF

REAL PARTY IN INTEREST

The real party in interest is Cindy Hadfield.

RELATED APPEALS AND INTERFERENCES

On information and belief, there are no related appeals or interferences to the above-identified application.

STATUS OF CLAIMS

Claims 1-5 stand rejected.

Claims 1-5 are appealed and claims 2-5 stand or fall with claim.

STATUS OF AMENDMENTS

The Amendment of December 27, 2007 have been entered.

## SUMMARY OF CLAIMED SUBJECT MATTER

The invention is summarized by referring to the specific parts of the specification and drawings.

An Internet-based check ordering and reordering system,

including:

a client computer system (#12, page 3, line 22, FIG. 1b);

an Internet-based server (#14, page 3, line 22, FIG. 1b) having a check order entry user interface remote from

and in operable communication with said client computer system (12), wherein said

Internet-based server (14) includes software for enabling input at said interface of client data, client

check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner;

a bank transit number computer system (#16, page 4, line 3, FIG. 1b) remote from and in operable

communication with the Internet-based server computer system having software for

receiving at least said client bank transit number data, said client bank account data, and

said client bank routing data from said Internet-based server and de-encrypting said client

bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation; and a printing station (#18, page 5, line 22, FIG. 1b) in operable communication with said Internet-based server computer system to print checks bearing said data thereon and a blank amount field.

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1 Whether claims 1-5 are unpatentable under 35 U.S.C. §103(a) as obvious over LAM United States Publication 2003/0074315 in view of Deluxe (www.deluxe.com).

#### ARGUMENT

##### Stated Grounds of Rejection by Examiner under 35 U.S.C § 103

In the Final Office Action dated 1/24/2008, the Examiner rejected to Claims 1-5. The Examiner stated:

Referring to Claim 1: Lam teaches an Internet-based check ordering and reordering system, including: a client computer system; an Internet-based server

having a check order entry user interface remote from and in operable communication with said client computer system (Lam: Abstract; Figures 1-3, #14; Page 2, Paragraphs 0031-0034//Lam shows an Internet-based check system consisting of a client terminal//),

Application/Control Number: 101647849 Page 3

Art Unit: 3692

wherein said Internet-based server includes software for enabling input at said interface of client data (Lam: Figure 10; Page 6, Paragraph 0061//Lam teaches a system which uses a Internet-based server in order to enable receipt of input at the client terminal device//), and a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon (Lam: Abstract; Page 1, Paragraphs 0002, 0006-0011, 0014//Lam discloses a system which prints checks to remote locations//).

Lam, however, does not expressly teach an Internet-based check ordering and reordering system, including: client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner; a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation.

Deluxe, in a similar environment, discusses an Internet-based check ordering and reordering system, including: client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner (Deluxe: Pages I — IV//Deluxe displays a system which allows a user to input a check number associated with a check and financial banking institution as well as account/routing information affiliated with a users account/I); a bank transit number computer system remote from and in operable communication with

the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database (Deluxe: Page II//Deluxe displays a system which employs a terminal unit in order for a user to enter associated account information and performs a verification procedure to verify user/I), and transmits to said Internet- based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing orientation; and a blank amount field (Deluxe: Pages I —IV//Upon complete system transaction, a user is able to print the checks as requested//).

At the time of invention it would have been obvious to modify the method of Lam by incorporating a feature for ordering and reordering checks with the invention of Deluxe in order to effectively create an online Internet-based check ordering and reordering system as disclosed for the purpose of increasing customer access to personal checks, etc. (Deluxe: Pages I — III).

Furthermore, the Examiner notes the disclosure of Lam as being a check ordering and reordering system and method wherein the reordering segment is inherent and well known. Reordering a check is done each time another check is ordered (hence, reordering) [See In re Harza MPEP2144.04.VI.BI. A system as such would additionally inherently possess checks; checks, with data that would consist of a bank branch name, a bank address, a bank branch number, and a blank amount field on the check.

#### The Nonobviousness Requirement - 35 U.S.C. §103

35 U.S.C. § 103 states a patent may not be obtained though the invention is not identically disclosed or described as set forth title 35 USC § 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

shall not be negated by the manner in which the invention was made.

The Supreme Court recently addressed the issue of obviousness in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). The Court stated that the Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), factors still control an obviousness inquiry. Those factors are: 1) “the scope and content of the prior art”; 2) the “differences between the prior art and the claims”; 3) “the level of ordinary skill in the pertinent art”; and 4) objective evidence of nonobviousness. KSR, 127 S. Ct. at 1734 (quoting Graham, 383 U.S. at 17-18). Moreover, the Court indicated that there is “no necessary inconsistency between the idea underlying the TSM test and the Graham analysis.” Id. As long as the test is not applied as a “rigid and mandatory” formula, that test can provide “helpful insight” to an obviousness inquiry. KSR, 127 S. Ct. at 1731; Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd., No. 06-1329 (Fed. Cir. June 28, 2007). It is also stated that “where an application claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result”. KSR, at 1739. In other words, if a person of ordinary skill can implement a predictable variation of known components, § 103 likely bars its patentability. KSR was concerned with substitution of a known component having a known function and substituting it into another invention for performing the same function.

At the outset, it is important to note how this case is not the same as the much publicized KSR case. KSR, 127 S.Ct. at 1740. Here, the applicant points out quite clearly that the art cited is deficient in lacking the claimed structure. There are indeed claimed differences between the prior art and the claims. At the time of the invention, the

level of skill in the art has not been shown to have developed as to the art nor as to any like claimed structure or disclosure in the cited art. The only evidence of record which has been offered at this time tilts toward patentability. The Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966):

While the ultimate question of patent validity is one of law, ... the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. 383 U.S. at 17-18 (citations omitted).

The Court also instructed that the standard set forth in *Graham* would go beyond an inquiry of purely technical issues:

These legal inferences or subtests do focus attention on economic and motivational rather than technical issues and are, therefore, more susceptible of judicial treatment than are the highly technical facts often present in patent litigation.... Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted to discharge the technological duties cast upon it by patent legislation. ... They may also serve to “guard against slipping into use of hindsight,” ... and to resist the temptation to read into the prior art the teachings of the invention in issue. 383 U.S. at 35-36 (citations omitted).

Thus, under *Graham*, the obviousness inquiry is highly fact specific, and requires an examination of the above stated factors.

### Cited Art and Reasons Why Examiner's Assertion is Incorrect

The examiner acknowledged that neither reference teaches, suggests, or discloses the claimed invention. Rather, the combination is submitted as a means of rendering obvious the claimed invention. To this end, the examiner provides a screenshot of a Deluxe web site in combination with the teaching of Lam.

Applicant respectfully submits that neither reference alone or in combination with the other teaches, suggests or discloses the invention. Lam simply discloses a system and apparatus for remotely printing certified documents. Particularly, Lam teaches a communication system for remotely and securely printing certified checks via the Internet and includes a customer communication device operative to initiate communication with a web server which is in communication with a system bank capable of creating an image file of the certified check which is securely encrypted and transmitted back to the customer via the Internet. Lam prints a "certified check" from a bank at a site remote to the bank wherein the remote site must have respective printing apparatus 15 (FIGS. 2 and 3) capable of printing certified documents. An encrypted image file of the requested certified check will be received at the customer location and printed using bank specified printer on pre-numbered check paper, which is issued by the bank and securely stored in the printer. This in no way teaches the claimed invention. Also, the cited screenshot of Deluxe appears to teach no more than what was known prior to the claimed invention. That is, Deluxe, provides a site to facilitate the order of checks by partnered relationships with financial institutions. This is similar to a middle man



operation wherein local printers are affiliated with the banks and perform the printing of checks for a particular bank and the web site appears to do no more than facilitating this.

Notably missing from the cited reference(s) is any teaching, disclosure or suggestion of the ability for obtaining local bank information, address, branch number in addition to the other bank and client information. Also missing is the element of the instant invention which compares at least the client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of the bank transit number computer system to verify that the client bank transit number corresponds to bank transit data in the database (i.e., the database being federally provided). This information is required in the instant invention in order to perform a validation and goes to the heart of the instant invention. By so providing, there is not only a reduced chance of misinformation but also a mechanism in which to more securely and accurately speed the process of check ordering and reordering. Further, there is provided a mechanism by which to reduce printing costs through reduced printing error and increased competition local printers. Currently, local banks have established relationships with a printer and govern the cost of check book reorders through these relatively noncompetitive relationships.

None of the prior art provides the claimed elements of the instant invention. The references fail to teach the instant invention and it is a great leap to imply that the combination of references teach this. There is simply no discussion, disclosure, suggestion or teaching whatsoever to do so, absent the instant invention.

It is recognized that the nonobviousness requirement extends the field of

unpatentable material beyond that which is known to the public under § 102, to include that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor. See *Graham*, 383 U.S., at 15, 86 S. Ct., at 692. As noted in 550 U. S. \_\_\_\_ (2007), Opinion of the Court ... SUPREME COURT OF THE UNITED STATES. No. 04–1350. KSR INTERNATIONAL CO., PETITIONER v. TELEFLEX INC., the Federal Circuit’s so-called “teaching- suggestion-motivation” standard for obviousness is also a helpful though not determinative test, wherein there must be some motivation or suggestion to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. See, e.g., *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), cert. denied, 532 U.S. 974 (2001) *Ashland Oil*, 776 F.2d at 293, and that teaching- suggestion-motivation cannot come from the invention, i.e., prevention of hindsight use.

The issue is here is whether Lam and/or Deluxe and some other knowledge (presumably the Examiner’s) brought here together renders obvious claimed invention. The Federal Circuit has followed the Court’s holding in *Adams*. See, e.g., *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1479-80 (Fed. Cir. 1998), cert. denied, 525 U.S. 875 (1998) (“In determining obviousness, the invention must be considered as a whole.”). Set aside Lam and Deluxe which Applicant asserts do not teach the invention, no other evidence has been put forth which teach, suggest or disclose the invention. Combining the references does no more than provide separate technologies which enable a user to order and/or reorder personal and business checks on the aforementioned manner.

Applicant has adequately rebutted the examiner’s contention. It is respectfully

submitted that the cited art, namely, Lam and Deluxe, do not render obvious the instant invention, to produce the claimed present invention. Combining Lam with Deluxe's teachings is not intuitive nor does it make sense or render the present invention as it is not understood why one would combine such teachings as they perform completely different tasks, i.e., Lam to send a single certified check to conduct a transaction such as a purchasing real estate verses Deluxe as a facilitator to reordering checks through the person's bank.

The differences between the prior art and claimed invention are very apparent. The level of ordinary skill in the art in the field of check book fulfillment has not been established and cannot be asserted without some reasonable basis for doing so. Claims 1-5 are respectfully submitted to be patentably distinct over the cited art. Withdrawal of the rejection of claims 1-5 is kindly requested.

### CONCLUSION

The instant invention is respectfully submitted to be patentably distinct over the art of record. Reversal of the rejection of the rejection of claims under 35 U.S.C. 103 over Lam in view of Deluxe and allowance of claims 1-5 are respectfully requested.

Respectfully submitted,

/R. William Graham/

R. William Graham

Reg. No. 33,891

### Certificate of transmission

I hereby certify that this Appeal Brief is being electronically filed with the Commissioner of Patent and Trademarks, Washington, D.C. 20231 on the date shown below.

Date. July 24, 2008

/ R. William Graham/

## CLAIMS APPENDIX

1. An Internet-based check ordering and reordering system,

including:

a client computer system;

an Internet-based server having a check order entry user interface remote from and in operable communication with said client computer system, wherein said Internetbased server includes software for enabling input at said interface of client data, client check number data, client bank transit number data including bank branch name, address and branch number, client bank account data, and client bank routing data at said check order user interface and has means for transmitting said bank client bank transit number data, said client bank account data, and said client bank routing data in an encrypted manner;

a bank transit number computer system remote from and in operable communication with the Internet-based server computer system having software for receiving at least said client bank transit number data, said client bank account data, and said client bank routing data from said Internet-based server and de-encrypting said client bank transit number data, said client bank account data, and said client bank routing data, and comparing at least said client bank transit number data with a data listing corresponding to transit number data for a plurality of banks within a database of said bank transit number computer system to verify that said client bank transit number corresponds to bank transit data in said database, and transmits to said Internet-based server verified check print data which includes said client bank transit number data, said client bank account data, and said client bank routing data and a predetermined printing

orientation; and

a printing station in operable communication with said Internet-based server computer system to print checks bearing said data thereon and a blank amount field.

2. The Internet-based check ordering and reordering system of claim 1, wherein software on said Internet based server includes means for billing a client at said user interface using said system.

3. The Internet-based check ordering and reordering system of claim 1, wherein said Internet-based server is operably associated with a database which contains and stores said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

4. The Internet-based check ordering and reordering system of claim 3, wherein said Internet-based server is further equipped to associate and store said received verified check information data from said bank transit number computer system with said client data, said client check number data, said client bank transit number data, said client bank account data and said client bank routing data.

5. The Internet-based check ordering and reordering system of claim 3, wherein said printing station includes a computer which is operably connected to said Internet-based server in a manner to receive said client data, said client check number data, said client bank transit number data, said client bank account data, said client bank routing data and said verified check print data in an encrypted form and deencrypts said data to enable printing of said checks.

#### RELATED PROCEEDINGS

There are no related proceedings.